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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/374,577	08/13/1999	FORREST NABORS	34533-51	3935
7590	02/24/2004		EXAMINER	
			CHOULES, JACK M	
			ART UNIT	PAPER NUMBER
			2177	
			DATE MAILED: 02/24/2004	
				19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/374,577	NABORS ET AL.
	Examiner	Art Unit
	Jack M Choules	2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 December 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-66, 69 and 70 is/are pending in the application.
- 4a) Of the above claim(s) 1-47 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 48-66, 69 and 70 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-66, and 69-70 are presented for examination. Claims 1-47 having been withdrawn from consideration. Claims 67 and 68 having been listed as canceled.

Response to Arguments

1. Applicant's arguments filed Dec. 11, 2003 have been fully considered but they are not persuasive.

2. To the argument against the 35 U.S.C. 101, the applicant argues that the claim 58-66 being drawn to a propagated signal, which is statutory subject matter as a carrier signal is a statutory article of manufacture.

3. In response to the argument against the 35 U.S.C. 101 the examiner respectfully disagrees the current office position is that a propagated signal is clearly not a statutory article of manufacture as it is not tangible physical matter or embodied thereon.

4. Concerning the rejection under 35 U.S.C. 103(a) of claims 48-66 and 69-70 over Rothrock and the Draft Proposal the applicants argue that Rothrock does not detail storage of standard and optional features, and neither Rothrock nor Draft Proposal detail "customer-centric information in private" data structures.

5. In response to the argument against the 35 U.S.C. 103(a) of claims 48-66 and 69-70 over Rothrock and the Draft Proposal the examiner respectfully disagrees as follows: the customer-centric information, standard features, and optional features are mere arrangements or compilations of data or facts merely stored in the data structure thus being nonfunctional descriptive material, further as claimed public and private are merely labels for the blocks having no claimed structure to enforce or act upon the labels the label are also considered nonfunctional descriptive material the difference being directed to data *Per Se* thus the difference is limited to non-functional descriptive material stored on a machine which cannot render an invention non-obvious for an invention that would otherwise have been obvious (see MPEP 2106 VI note: MPEP 2106 IV B 1 (b) defines nonfunctional descriptive material).

6. Concerning the rejection under 35 U.S.C. 103(a) of claims 48-66 and 69-70 over Rothrock and Kozal the applicants argue that storage of standard and optional features, and neither Rothrock nor Draft Proposal detail “customer-centric information in private” data structures or that storage of standard and optional features.

7. In response to the argument against the 35 U.S.C. 103(a) of claims 48-66 and 69-70 over Rothrock and Kozal the examiner respectfully disagrees as follows: the customer-centric information, standard features, and optional features are mere arrangements or compilations of data or facts merely stored in the data structure thus being nonfunctional descriptive material, further as claimed public and private are merely labels for the blocks having no claimed structure to enforce or act upon the labels the label are also considered nonfunctional descriptive material the difference being directed to data *Per Se* thus the difference is limited to non-functional descriptive material stored on a machine which cannot render an invention non-obvious for an invention that would otherwise have been obvious (see MPEP 2106 VI note: MPEP 2106 IV B 1 (b) defines nonfunctional descriptive material).

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 58-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are apparently directed to a Data structure Per se as it is not clearly claimed as embodied in a computer readable media. See Warmerdam, 33 F.3d at 1360-1361 (claim to computer having specific memory held statutory, claim to data structure per se held non-statutory).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 48-66 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothrock, US Patent Number 5,748,618 in view of Draft Proposal [hereinafter the draft] “An Industry Standard Data Format for the Export and Import of Automotive Customer Leads”** (Note: the draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject mater of the claims is not found in that application.)

2. As to claims 48, 58, 69 and 70 the Rothrock disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure 3); “a public block” (figure 3, index 310), “a private block” (figure 3, index 302) and the general principle of and blocks sub-blocks and categories and data items (figure 3).

3. The draft does not detail delimiters and the specific blocks sub-blocks and categories and data items claimed. The draft describes delimiters (page 6-14); and the specific blocks sub-blocks and categories and data items claimed (page 6-14). No attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example “manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non- functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385,

217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

4. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of the draft with Rothrock because the draft includes personal data (draft page 3) and it would have been obvious to protect this data from public distribution to protect the interests of the client in the system also the draft shows the particular the need to set up databases directed to the automotive area was known and accepted and the necessary elements to include in such a database.

5. As to claims 49, 50, 59, and 60, in the draft delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (page 6-14) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierachal structure.

6. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

7. As to claims 56-66, the draft details XML (page 3).

8. **Claims 48-66 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothrock, US Patent Number 5,748,618 in view of Kozol et al. [hereinafter the Kozol] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads"**

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9. As to claims 48, 58, 69 and 70 the Rothrock disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure 3); "a public block" (figure 3, index 310), "a private block" (figure 3, index 302) and the general principle of and blocks sub-blocks and categories and data items (figure 3).

10. Rothrock does not detail delimiters and the specific blocks sub-blocks and categories and data items claimed. Kozol delimiters (figure 1); and blocks sub-blocks and categories and data items (figure 1.). No attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non- functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

11. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Kozol with Rothrock because the draft includes personal data (draft page 3) and it would have been obvious to protect this data from public distribution to protect the interests of the client in the system also Kozol shows the particular the need to set up databases directed to the automotive area was known and accepted and the necessary elements to include in such a database.

12. As to claims 49 and 50, the delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (figure 1) further linking the

delimiters to the hierarchical element they depend on is considered obvious to maintain the hierachal structure.

13. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

14. As to claims 56 and 66, Kozol details SGML (abstract) XML is a standard derived from SGML so it would be obvious to also use the features of the Kozol invention with XML, as it would extend to the functionality to the new standard.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

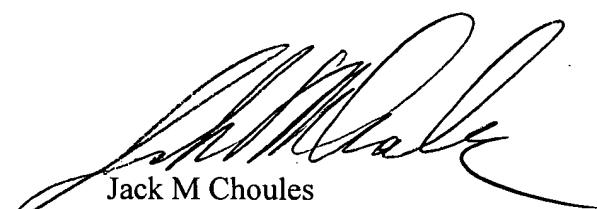
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (703) 305-9840. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules
Primary Examiner
Art Unit 2177

21 February 2004